

REMARKS

Claims were 16-22 and 30-34 were pending in the application. Claim 18 has been canceled, without prejudice, and claim 16 has been amended. Accordingly, after the amendments presented herein have been entered, claims 16, 17, 19-22 and 30-34 will be pending in the instant application. *No new matter has been added.*

Claim 16 has been amended to include the limitations of claim 18. Accordingly, support for the amendments to claim 16 can be found throughout the specification and claims as originally filed.

Election/Restriction:

In the Restriction Requirement set forth in the Office Action mailed September 26, 2002, the Examiner required restriction between one of the following inventions:

- Group I: Claims 16-17, 19-22, drawn to a method for screening for agents that modulate IgE production, classified in class 435, subclass 7.8.
- Group II: Claims 18, 29-33, drawn to a method for screening for agents that modulate IgE production wherein the cell comprises a fusion protein, classified in class 435, subclass 7.71.

It is the position of the Examiner that these inventions are distinct from each other because:

the methods are practiced with materially different starting materials, have materially different process steps, and are for materially different purposes. In the instant case the method of invention II uses cells expressing a fusion protein, thus the starting materials are different. Further, the process steps are different because in the method of invention II the cells must be transfected with a nucleic acid expressing the fusion protein, while this step is not necessary in invention I. The methods are for different purposes because the method of invention I will identify agents which modulate IgE production, while the method of invention II will identify agent which modulate the function of a fusion protein.

Applicants respectfully submit that in the Preliminary Amendment filed on September 25, 2001, claim 29 was canceled. Accordingly, claim 29 should not be included in Group II. In addition, in the same Preliminary Amendment, claim 34 was added. It appears that the Examiner has omitted claim 34 from the instant Restriction Requirement. Applicants will assume that the Examiner had intended to include claim 34 within Group II. Accordingly, Applicants assume Group II includes claims 18 and 30-34. Clarification by the Examiner is respectfully requested.

Applicants' respectfully traverse the foregoing Restriction Requirement and submit that the requirement is improper. However, in order to be considered responsive to the instant Office Action, Applicants' hereby elect Group I (claims 16-17, 19-22), *with traverse*. Applicants traverse the restriction requirement to the extent that groups I and II should be reformed as a single group containing claims 16-22 and 30-34 (referred to hereinafter as "*newly formed Group I*"). Applicants' grounds for traversal are set forth below.

Contrary to the Examiner's position, the methods of the claims of Groups I and II are for the same purpose, *e.g.*, to screen for a bioactive agent that modulates IgE production. Moreover, the starting materials are the same, *e.g.*, a candidate bioactive agent and a cell expressing IgE, and the claimed methods have the same process steps, *e.g.*, contacting a candidate bioactive agent and a cell expressing IgE and determining the amount of IgE produced in the cell.

In addition, as Groups I and II are of the same class, a literature search of both Groups I and II would be nearly, if not completely, co-extensive.

Accordingly, Applicants respectfully submit that a sufficient search and examination with respect to the claimed methods can be made without serious burden on the Examiner. As the M.P.E.P. states:

[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. M.P.E.P. § 803.

Applicants respectfully submit that the search with regard to methods for screening for bioactive agents that modulate IgE production (claim 16) would be coextensive with a search for methods of screening for bioactive agents that modulate IgE production according to claim 18, and would not place a burden on the Examiner.

Applicants have amended claim 16 to include the limitations of claim 18 and claim 18 has been canceled. Accordingly, Applicants submit that Group I is directed to methods of screening for a bioactive agent that modulates IgE production, comprising contacting a candidate bioactive agent and a cell expressing IgE, wherein the cell comprises an IgE fusion protein comprising an ϵ heavy chain, and a fluorescent protein, and determining the amount of IgE produced in the cell, where a change in the amount of IgE as compared to the amount produced in the absence of said candidate agent indicates that the agent modulates IgE production, and should include claims 16, 17, 19-22 and 30-34.

CONCLUSION

If a telephone conversation with Applicants' Attorney would expedite prosecution of the above-identified application, the Examiner is urged to call the undersigned at (617) 227-7400.

Respectfully submitted,

LAHIVE & COCKFIELD, LLP

By:

A handwritten signature in black ink, appearing to read "MEG-EL", written over a horizontal line.

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